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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,654	12/21/2000	Michael Hanington	AVERP2850US	7505

7590 05/10/2004

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	09/742,654	HANNINGTON, MICHAEL	
	Examiner	Art Unit	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 32-95 is/are pending in the application.
- 4a) Of the above claim(s) 53-95 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-29 and 32-52 is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/11/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's remarks filed on 4/1/2004, and an Information Disclosure Statement (IDS) filed on 3/11/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicant's argument that "The crosslinked silicone layer is not embedded into the pressure sensitive adhesive layer" (Remarks, page 3, third full paragraph) is persuasive. As such, the rejection over Calhoun et al. has been withdrawn.
4. This application contains claims 53-95 drawn to an invention nonelected with traverse in Remarks filed 12/9/2002. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Remarks

5. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, substantially for the reasons set forth in sections 3 and 5 of Paper No. 20, together with the following additional observations.

With respect to Applicant's argument that "the Examiner's ongoing discourse regarding whether the pressure sensitive adhesive is "cured" or "polymerized" is irrelevant. The declaration of Mr. Hannington explains that the pressure sensitive layer

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can possess cohesive strength and tackiness at the same time. This principle is well known in the art. Support for this well known principle has been provided previously by the Applicant in the excerpt from Adhesion and Adhesives Technology by Alphonsus B. Pocius." (Remarks, page 2, third paragraph), the Examiner notes that while it is well known that the pressure sensitive layer can possess cohesive strength and tackiness at the same time, the argument presented in Mr. Hannington's declaration stating that "Pressure sensitive adhesives, as used by the consumers, are typically fully cured system ..." (Declaration, section 5) is clearly erroneous, and renders the declaration defective. The Examiner repeats (see Paper No. 010704, page 2) that the Declaration appears to have confused "polymerization" as "curing" (or crosslinking) of polymer, since while it is known that pressure sensitive adhesive are fully polymerized polymer, it cannot be fully cured (or crosslinked) polymer, as the curing would inherently restrict the mobility of polymer chain and render the adhesive non-tacky or non-adhesive.

With respect to Applicant's argument that "as described in the specification at page 15 with reference to figures 3a-3c, it is the channels 35 created by the printing process that are collapsed, not the non-adhesive material forms themselves that are collapsed. The non-adhesive material form are embedded into the adhesive layer to create the channels. As explained in the Declaration, even with modest application of pressure the combination of the geometric contact area of the adhesive and the viscoelastic properties of the adhesive allows the adhesive to debond readily under the pattern of non-adhesive material forms ... This is contrary to the Examiner's unsupported statement that "the non-adhesive material forms appear to be irrelevant" to

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the air egress property.” (Remarks, pages 2-3, bridging paragraph), the Examiner again repeats (see Paper No. 010704, page 3) that Mr. Hannington’s Declaration fails to provide evidentiary support regarding the feasibility of how the adhesive can be pulled away from the substrate to form air egress routes as shown in Fig. 3c by a pressure, which also causes the non-adhesive material forms to collapse to (fall onto) the facestock permanently (in the absence of any enabling attachment mechanism), which appears to be highly unlikely. Additionally, while section 8 of the Declaration describes a conventional air egress process, section 9 is clearly deficient to provide a enabling rationale for claims 1-26, because Mr. Hannington’s Declaration argues that any “standard adhesive tape” can be pushed by finger pressure against entrapped air bubble, so as to provide the claimed air egress property, which is clearly unrelated to the specific embodiment as shown in Figs. 3b and 3c of the instant invention. As such, it is the Examiner’s position that the Declaration fails to provide specific enabling evidentiary support for forming air egress channels of Fig. 3c by “finger pressure”, and the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Allowable Subject Matter

6. Claims 27-29 and 32-52 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The Examiner notes that Applicant’s argument is persuasive, and the rejection

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over Calhoun is withdrawn as set forth above. Additionally, Applicant's Remarks filed 12/1/2003 arguing that "The method by which the wall covering of Rusincovitch is produced could not have produced Applicant's claimed adhesive article. Specifically, because an adhesive is first coated over the spacers and the adhesive layer with the spacers printed thereon is transferred to the wall covering substrate, the bottom surface of the spacers could not have been positioned above the plane of the lower surface of the adhesive layer as illustrated in Figures 4a and 4b of the present application."

(Remarks filed 12/1/2003, page 3, second full paragraph) have been carefully considered, and are persuasive. As such, claims 27-29 and 32-52 are unobvious over Rusincovitch in view of GB 1511060.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zinker